IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of:	Examiner: Michael Young Won
Hemingway Huynh et al.	Art Unit: 2155
Application No.: 10/611,698	Confirmation No.: 4440
Filed: 06/30/2003	
For: ADAPTIVE MEDIA MESSAGING, SUCH AS FOR RICH MEDIA MESSAGES INCORPORATING DIGITAL CONTENT	

Mail Stop Appeals
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE APPEAL BRIEF REQUEST FOR REVIEW

INTRODUCTORY COMMENTS

All of the pending claims of the above-captioned application were rejected in the Final Office Action mailed October 9, 2007 (hereinafter "Office Action"). The Applicants hereby appeal this decision of the Examiner to the Board of Patent Appeals and Interferences according to 35 U.S.C. § 134 and submit a Notice of Appeal in compliance with 37 C.F.R. § 41.31 contemporaneously with the present request. Prior to the filing of the Appeal Brief, the Applicants respectfully request review of the legal and factual basis of the rejections in the above-captioned application in light of the remarks to follow.

STATUS OF CLAIMS

Claims 1 -10, 34, and 40 – 43 stand rejected under 35 U.S.C. §103(a) as being obvious over Sahai et al. (U.S. Patent No. 6,597,699) (hereinafter "Sahai") in view of Dunning et al. (U.S. Patent No. 7,024,485) (hereinafter "Dunning").

REMARKS

103 rejections

As is well established, a proper 103 rejection requires that a combination of references makes the claimed invention, when considered as a whole, obvious. Whether a combination of teachings makes an invention obvious is a question of law based on the underlying factual inquiries presented in *Graham v. John Deer Co.*, 383 U.S. 1 (1966). The *Graham* factors include determining the scope and content of the prior art; ascertaining the differences between the claimed invention and the prior art; and determining the ordinary skill in the art. When properly guided by these inquiries, it is clear that a person of ordinary skill in the art would not find the invention obvious in light of the prior art (presented as the Sahai and Dunning[1] references).

Sahai teaches a client device that requests content through a server and provides the server with information on the client device's capabilities. This information may be provided along with the request or as a response to a query from the server. Either way, the logic for testing the client device's capabilities resides on the client device. *Sahai* column 6, lines 9 – 11. The server will then retrieve the requested content and adapt the content prior to delivery according to the client's capabilities.

Dunning teaches scalable coding of streaming content. Primary information is sent to a client first (which could be played at a low quality level) and then, as time permits, secondary information may be sent. The secondary information may be used in combination with the primary information to play the content at a high-quality level.

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[1] Dunning's filing date of November 8, 2002 is later than the present application's priority date of July 1, 2002. While Dunning claims priority to Application No. 09/846,823, filed April 30, 2001, it is questionable whether the subject matter relied upon by the Examiner is properly supported by this earlier date. The specifications of these two applications are clearly different.

Claim 1 of the present invention, recites an article comprising a storage medium and instructions, stored in the medium, which, when executed by a processor cause the processor to generate and transmit one or more messages to a receiving computer system. The one or more messages include:

> a media message to be displayed on the receiving computer system as a first layer of an adaptive media message, the media message including a link;
> logic for testing digital content capabilities of the receiving computer system when the link is dereferenced; and
> logic for displaying a selected one of a plurality of versions of digital content selected based on the results of testing digital content capabilities of the receiving computer system, such that the receiving computer system may display the selected version of the digital content in the media message as a second layer of the adaptive media message.

The differences of the invention as recited in claim 1 and the combination of cited references at least includes the generation and transmission of one or more messages that include a media message, which is displayed as a first layer of an adaptive media message, having a link; and logic for testing digital content capabilities of the receiving computer system when the link is dereferenced.

First, neither reference teaches or makes obvious a message that includes testing logic being sent to the receiving computer system. As stated above, Sahai only teaches that the testing logic is stored on the client computing device. There is no teaching or suggestion that the logic be transmitted to the receiving computing device, much less that the logic is tied to a dereferencing of a link transmitted with the first layer, discussed in further detail below. Dunning does not mention testing client capabilities at all.

Second, neither reference teaches or makes obvious inclusion of the link, which when dereferenced activates the testing logic, in the media message this is displayed as a first layer of an adaptive media message. The Examiner relies on both Sahai and Dunning to provide this teaching. In both references, the relied upon teaching discusses a user clicking on a URL to request content. This is clearly out of context as the links are not a part of the media message that is displayed as the first layer of the

adaptive media message and they do not activate the testing logic when dereferenced, they simply form the request for content.

The Examiner's reliance upon this teaching in this manner clearly violates the mandate provided by *Diamond v. Diehr* that states "office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." 450 U.S. at 188-89. Instead, the claim as a whole must be considered. *Id*.

When considering the claim as a whole, it is clear that the first layer of the adaptive message has the link that activates testing logic, which is transmitted to the receiving computing device in the one or more messages. The activation of the testing logic may result in the message being adapted according to the tested capabilities of the receiving computer system.

Furthermore, while the above discussion sufficiently differentiates the link of claim 1 from the "link" taught by Dunning, the Applicants would like to point out that this teaching of Dunning appears to be unsupported by the application providing Dunning's earliest priority date.

The differences between claim 1 and the cited references are both significant and meaningful. These differences contribute to claim 1, as a whole, providing a media message that can be sent to a receiving computer system in a manner that allows for the message itself to facilitate testing of, and adaptation to, the capabilities of the receiving environment. This adaptable message may be sent to any computer system capable of receiving such messages without the need for preexisting knowledge of the characteristics of the receiving computer system or routing through a particular transcoding server.

For at least these reasons, a person of ordinary skill in the art would not find claim 1, when considered as a whole, obvious in light of the cited references.

The remaining claims, e.g., claims 2 – 10, 34, and 40 – 43 depend from, or include limitations similar to, claim 1. Accordingly, they are patentable over these references for at least the reasons given above.

CONCLUSION

In view of the foregoing, the Applicants submit that the factual and legal basis for Examiner's rejections is clearly erroneous. As such, a notice of allowance is respectfully submitted. In the alternative, the Applicants request that prosecution on the merits be reopened.

If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 500393.

Respectfully submitted,
Schwabe, Williamson & Wyatt, P.C.

Dated: 12/10/2007

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 111255-135502

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on 12/10/2007

Signature /Sally Houk/

Typed or printed name Sally Houk

Application Number	Filed
10/611,698	30-Jun-2003

First Named Inventor: Hemingway Huynh

Art Unit	Examiner
2155	Won, Michael Young

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 51110.
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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12/10/2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

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